

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 35, 36, 42, 45-47 are pending in the application, with 35 and 42 being the independent claims. Claims 35, 42 and 47 are sought to be amended. Support for the amendments can be found, for example, in the specification at page 120, lines 7-11, page 32, line 28 - page 33, line 2, and page 20, line 17 page 21, line 23. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Claim to Priority***

The Examiner has noted that the section on cross-reference to related applications does not follow the title of the invention as the first paragraph of the specification. Pursuant to 37 C.F.R. § 1.77(b), Applicants have amended the specification to insert the paragraph on related applications, directly following the title of the invention, on the first page of the specification. Applicants have also amended the specification to update the claim to priority.

***Rejections under 35 U.S.C. § 112***

The Examiner has rejected claims 35, 36, 42, 45-46 and 47 under 35 U.S.C. § 112, second paragraph for allegedly "...being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (Paper No. 20, page 3). Applicants respectfully traverse the Examiner's rejection.

Specifically, the Examiner contends that the metes and bounds of the claims are not clearly determined as it is "...unclear what is encompassed by the phrase 'encoding 400 contiguous amino acids or less of a Jak 3 peptide of SEQ ID NO:16, wherein said peptide contains the sequence of SEQ ID NO:15 which includes the Jak 3 autophosphorylation site.'" (Paper No. 20, page 3). Solely in an effort to advance prosecution, and without acquiescence in the propriety of the Examiner's rejection, Applicants have amended claim 35, from which claims 36, 45 and 46 depend, to remove the recitation of "wherein said peptide contains the sequence of SEQ ID NO:15." Amended claim 35 now recites "wherein said peptide contains the Jak3 autophosphorylation site, wherein said Jak3 autophosphorylation site includes the amino acid sequence KDYY."

Regarding claim 47, the Examiner states that "it is unclear what is encompassed by the phrase 'wherein said molecule encodes a Jak 3 polypeptide that is at least 80-99% homologous to the amino acid sequence of SEQ ID NO:16.'" (Paper No. 20, page 3). Solely in an effort to advance prosecution, and without acquiescence in the propriety of the Examiner's rejection, Applicants have amended claim 47 to recite "...a Jak 3 polypeptide that is at least 80-99% homologous to the corresponding 400 amino acid sequence of SEQ ID

NO:16...." In view of the above amendments, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

***Rejections under 35 U.S.C. § 102***

The Examiner has rejected claim 35 under 35 U.S.C. § 102(a) as allegedly being anticipated by Fuortes, M. (Genbank Accession No. U08340), claims 35-36 as allegedly being anticipated by Kawamura *et al. Proc. Natl. Acad. Sci.* 91:6374-6378 (1994) and claim 42 by Kawamura *et al. Id.*, as evidenced by Kennell. *Progr. Nucl. Acid Res. Mol. Biol.* 11:259-301 (1971). Applicant's respectfully traverse the rejection.

Solely in an effort to advance prosecution, and without acquiescence in the propriety of the Examiner's rejection, Applicants have amended claims 35, from which 36 depends, and claim 42 to recite "a Jak 3 peptide of SEQ ID NO:16, wherein said peptide contains the Jak3 autophosphorylation site, wherein said Jak3 autophosphorylation site includes the amino acid sequence KDYY."

In any event, Kawamura is not proper art against the application. On August 28, 2001 Applicants submitted declarations under 37 C.F.R. § 1.131 from the inventors Drs. Bruce Witthuhn, James Ihle and Ollie Silvenoinen. The declaration addresses the embodiments of the inventions related to DNA molecules comprising a DNA sequence encoding an amino acid sequence of a Jak3 kinase peptide and a vector and host cell comprising said DNA. This declaration establishes that prior to April 1994, Applicants had in their possession a full-length clone containing the murine Jak3 sequence (See Paragraph 10 of the Declaration). Thus, the declaration establishes that the Applicants' were in

possession of a DNA molecule encoding the murine Jak3 peptide (SEQ ID NO:16), prior to April 1994.

The undersigned was previously informed by the publisher of Kawamura *et al.* that it published on July 5, 1994. Therefore, in light of the amendment removing the reference to SEQ ID NO:15 in claims 35 and 42, and based on the § 1.131 declaration, Applicants' present invention predates Kawamura *et al.* As such, Kawamura is not proper art under 35 U.S.C. § 102(a). Furthermore, based on the amendment to claim 35, which no longer refers to SEQ ID NO:15, the rejection based on the Fuortes reference is now moot. Thus, the rejection of claims 35, 36 and 42 is overcome and Applicants respectfully request that the Examiner withdraw the rejection.

***Rejections under 35 U.S.C. § 103***

The Examiner has rejected claims 35, 45 and 46 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawamura *et al. Proc. Natl. Acad. Sci.* 91:6374-6378 (1994) in view of Avraham *et al.* (International Publication Number WO 93/15201). Applicants respectfully traverse.

Specifically the Examiner contends that based on the teachings of Avraham *et al.* "[i]t would have been obvious for an ordinary skilled artisan to subclone the cDNA sequence disclosed by Kawamura *et al.* into an expression vector and transform a host cell with such a vector." (Paper, No. 20, page 8). Solely in an effort to advance prosecution, and without acquiescence in the propriety of the Examiner's rejection, Applicants have amended claim 35, from which 45 and 46 depend, to recite "a Jak 3 peptide of SEQ ID NO:16, wherein said

peptide contains the Jak3 autophosphorylation site, wherein said Jak3 autophosphorylation site includes the amino acid sequence KDYY." Applicants reiterate from above that based on the declaration filed August 28, 2001, Kawamura *et al.* cannot be considered proper art under art under 35 U.S.C. § 102(a). Therefore, Kawamura cannot be combined with Avraham *et al.* to make a 103 rejection. In view of the amendment of claim 35 and the previously submitted declaration, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

***Rejection of claim 42 - Obviousness-Type Double Patenting***

The Examiner has rejected claim 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent 6,136,595. Applicants respectfully traverse.

The Examiner maintains that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other." (Paper No. 20, page 9). Applicants disagree and comment that an obviousness-type double patenting rejection should only be made when the claims of the current application would be obvious in view of the claims U.S. Patent No. 6,136,595 (cited by the Examiner). This is not the case. The claims of the current application are not obvious in view of the claims of U.S. Patent No. 6,136,595.

The Federal Circuit in *General Foods Corp. v. Studiengesellschaft KmBH*, 23 USPQ2d 1839 (Fed. Cir. 1992) reiterated the necessity of comparing *only* the claims in the applications rejected on obviousness-type double patenting grounds. In order for the obviousness-type double patenting rejection to stand the Examiner must show that claim

42 is obvious in view of claims 1-6 of U.S. Patent No. 6,136,595. This has not been done. Therefore, the obviousness-type double patenting rejection is incorrect and should be withdrawn.

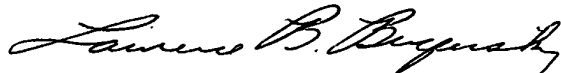
### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Lawrence B. Bugaisky  
Attorney for Applicants  
Registration No. 35,068

Date: August 8, 2003  
1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600